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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,771	02/18/2004	Harald Schaty	A-10035	1637
181	7590	09/21/2007	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			CHEVALIER, ALICIA ANN	
		ART UNIT	PAPER NUMBER	
		1772		
		NOTIFICATION DATE	DELIVERY MODE	
		09/21/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/779,771	SCHATY, HARALD	
	Examiner Alicia Chevalier	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 May 2007 and 20 June 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 7-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **RESPONSE TO AMENDMENT**

1. Claims 1-11 are pending in the application, claims 5 and 6 are withdrawn from consideration.
2. Amendments to the claims, filed on June 20, 2007, have been entered in the above-identified application.

### **WITHDRAWN REJECTIONS**

3. The 35 U.S.C. §112 rejections of claim 7, made of record in the office action mailed January 18, 2007, pages 2-3, paragraph #5 have been withdrawn due to Applicant's response filed May 18, 2007.
4. The 35 U.S.C. §103 rejection over Sakaki et al. (U.S. Patent No. 6,090,463) and evidences by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176, made of record in the office action mailed January 18, 2007, pages 3-4, paragraph #6 has been withdrawn due to Applicant's response filed May 18, 2007.

### **REJECTIONS**

5. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 103***

6. Claims 1, 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itada et al. (U.S. Patent No. 6,638,602) and evidences by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176.

Itada discloses an object (*title*) of synthetic thermoplastic adhesive material (*col. 5, lines 14-30*). The object has a contact surface that is rough, where  $R_z$  is in a range from  $40\mu$  to  $100\mu$ , more specifically  $55\mu$  to  $70\mu$  (*col. 5, lines 58-59*). The rough adhesive material is deemed to contact surfaces occupy the entirety of the opposite sides of the disk-shaped object (*figure 5*).

Itada fails to disclose that the adhesive device is disk-shaped/ annulus with a central hole.

It would have been an obvious matter of design choice to change the shape of adhesive, since a modification would have involved a mere change in size of the adhesive. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). Furthermore, one of ordinary skill in the art would have been motivated to change shape in order adapt the adhesive to different surfaces. As evidenced by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176 adhesives can be made in to disk shapes to suit different user needs.

The limitation “for use as an intermediate between parts” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

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7. Claims 3, 4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itada et al. (U.S. Patent No. 6,638,602) as applied above, and further in view of Mascarenhas et al. (U.S. Patent No. 5,888,615).

Itada is relied upon as described above.

Itada fails to disclose the arithmetic mean roughness Ra lines in the range from 6 $\mu$  to 25 $\mu$ , more specifically 10 $\mu$  to 15 $\mu$ .

Mascarenhas teaches an adherent article with an arithmetic mean roughness Ra lines in the range from 6 $\mu$  to 25 $\mu$ , more specifically 10 $\mu$  to 15 $\mu$  (*col. 11, lines 10-14*), so that the article can be easily removed from a substrate without leaving residue (*col. 1, lines 56-59*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make Itada's article with an arithmetic mean roughness Ra lines in the range from 6 $\mu$  to 25 $\mu$  as taught by Mascarenhas in order to insure that the article can be easily removed from a target article without leaving a residue.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments in the response filed May 18, 2007 regarding the 35 USC 103 rejection over Sakaki of record have been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments in the response filed May 18, 2007 regarding the 35 USC 103 rejection over Itada of record have been considered but are unpersuasive.

Applicant argues that there is no teaching or suggestion of a disk-shaped object of synthetic thermoplastic adhesive material having adhesive contact surface on opposite sides of

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the object that have a specified roughness, as recited in claim 1, nor an object in which the rough adhesive material contact surface occupy the entirety of the opposite sides of the object, as recited in claim 7.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Furthermore, Applicant has not addressed the examiner's obviousness rational. It remains the Examiner's position that the claims are unpatentable for the reasons above.

10. Applicant's arguments in the response filed May 18, 2007 regarding the 35 USC 103 rejections over Itada in view of Mascarenhas of record have been considered but are unpersuasive.

Applicant argues that Mascarenhas teaches nothing about a disk-shaped object in which adhesive material contact surface on opposite sides of the object, etc.

The examiner was not relying upon Mascarenhas to discloses these limitations. Furthermore, Applicant's arguments regarding these limitations have already been addressed above.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490.

The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac AF  
9/15/07

*Alicia Chevalier*  
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PRIMARY EXAMINER